REMARKS

Claims 1 and 3-13 are pending in this application. By this Amendment, claims 1 and 8 are amended. Support for the amendment to the claims may be found, for example, throughout the specification and in the original claims. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance, for the reasons discussed therein; (b) do not raise any new issue requiring further search and/or consideration, as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1 and 3-13 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By this Amendment, claims 1 and 8 are amended in light of the Examiner's comments.

In view of the amendments to the claims, Applicants respectfully submit that a person of ordinary skill in the art would understand the scope of the amended claims, and thus the amended claims serve the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

As provided by MPEP §2173.02, the essential inquiry is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and

particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

a. The content of the particular application disclosure;
b. The teachings of the prior art; and
c. The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

The claim must be considered as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Furthermore, breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

In view of the content of specification, teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, Applicants respectfully submit that a person of ordinary skill in the art would understand the scope of the amended claims, and thus the amended claims serve the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See MPEP §2173.03. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

II. Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 1 and 3-13 under 35 U.S.C. §103(a) over JP A 02-172956 in view of Labeeuw et al., Tetrahedron; *Asymmetry* 15 (2004) 1899-1908 (hereinafter "Labeeuw"). Applicants respectfully traverse the rejection.

Labeeuw is not available as prior art against the instant claims. The present application is the national phase of International Application No. PCT/JP2004/009829, filed on July 9, 2004, and claims priority benefit of JP 2003-272637 (filed on July 10, 2003) and JP 2003-426226 (filed on December 24, 2003). Submitted herewith is, upon information and belief, an accurate certified translation of JP 2003-426226. As is evident from the translation of JP 2003-426226 attached hereto, the pending claims are fully supported by JP 2003-426226. Accordingly, the pending claims are entitled to the benefit of, at latest, the December 24, 2003 filing date of JP 2003-426226.

Labeeuw became available to the public on June 4, 2004. As Labeeuw was published after the December 24, 2003, Labeeuw is not available as prior art against the present application under 35 U.S.C. §102(a) or §102(b) for a purpose of the §103(a) rejection.

For the foregoing reasons, Labeeuw is not available as prior art against the instant claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of this application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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JAO:AQS/sxl

Attachment:
English Translation of JP 2003-426226 and Declaration regarding its accuracy

Date: April 6, 2010

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